

English translation of the First Office Action

Mailing Number: 410411

Mailing Date: June 15, 2010

Patent Application No.: 2006-545916

Draft Date of Office Action: June 8, 2010

Examiner: Mr. Yasunori SHIMIZU 3605 2V00

Representative of Applicant: Mr. Yasuo ISHIKAWA

Article on which rejections/objections are based: Articles 29(2) and 36

It is considered that the present application be rejected under the following reasons. A response to the Office Action may be filed within the term of three months from the mailing date of the Action.

REASONS

(Reason 1)

The claims of the present application do not satisfy the requirements of Article 36(6)(1) of Japanese Patent Law under the reasons mentioned below.

Remarks

Recitation of claim 12 does not correspond to the detailed description of the invention.

Claim 12 recites that the second optical boundary face reflects the second partial beam path toward the first optical boundary face and reflects the second partial beam path in the direction of the second object.

However, the detailed description of the invention describes that the second partial beam path, which has been reflected toward the first optical boundary face by the second optical boundary face, is reflected by the first partial beam path in the direction of the second object.

(Reason 2)

It would have been obvious to a person with ordinary skill in the art to which the invention pertains, to make obviously an invention claimed in the following claims, prior to the filing of the patent application, on the basis of an invention or inventions disclosed in the following references distributed, or made available to the public through electric telecommunication lines in Japan or elsewhere prior to the filing of the patent application. A patent shall not be granted for such an invention under Article 29(2) of Japanese Patent Law.

Remarks (concerning the references, see a list of the references)

- Rejected claim(s): Claims 1, 2 and 11
- Cited reference(s): References 1 to 3
- Note:

Reference 1 describes a comparison microscope, which comprises objective optical systems each having a reflection prism; an image matching prism for synthesizing visual fields of two objective optical systems; and an eyepiece optical system for reflecting a comparative image. This reference also describes that a sample is illuminated through a condenser (see page 1, left-hand column, line 4 through right-hand column, line 39; and FIGS. 1 and 2).

Reference 1 does not describe a camera unit being disposed in the eyepiece optical system.

However, it has been well known to a person having ordinary skill in the art in a technical field of a microscope before the filing date of the present application to dispose a camera unit in an eyepiece optical system to observe an image as obtained (see References 2 and 3).

It would therefore have been obvious to a person having ordinary skill in the art to dispose the camera unit in the eyepiece optical system of the invention described in Reference 1 to make the invention of claims 1, 2, and 11 of the present application.

- Rejected claim(s): Claims 3 and 4

· Cited reference(s): References 1 to 5

· Note:

It has been well known to a person having ordinary skill in the art before the filing date of the present application to use an light-emitting diode as a light source for illumination (see References 4 and 5).

It would therefore have been obvious to a person having ordinary skill in the art to use the above-mentioned well-known thing as the light source of the invention described in Reference 1 to make the invention of claims 3 and 4 of the present application.

· Rejected claim(s): Claims 5 to 7

· Cited reference(s): References 1 to 5

· Note:

Reference 1 in which the optical axis of the eyepiece optical system coincides with the optical axis of the objective optical system and the outputting direction of illumination, does not describe that the optical axis of the eyepiece optical system, the optical axis of the objective optical system and the outputting direction of illumination are placed in an inclined manner.

However, inclination of the optical axis of the eyepiece optical system and arrangement merely represent obvious design choices, which may be determined appropriately by a person having ordinary skill in the art based on sizes of an object to be observed and an observing apparatus, as well as observability.

Therefore, inclining the optical axis of the eyepiece optical system of the invention described in Reference 1 relative to the optical axis of the objective optical system and the outputting direction of illumination would have been within a normal creative activity of a person having ordinary skill in the art and the invention of claims 5 to 7 of the present application would have been made obviously from the inventions described in References 1 to 5.

· Rejected claim(s): Claims 8 and 9

· Cited reference(s): References 1 to 7

· Note:

In Reference 1, a small stage and a large stage are moved for comparison of the other portion of a sample, but the respective objective optical systems are not moved for comparison of the other portion of the sample.

However, it has been well known to a person having ordinary skill in the art before the filing date of the present application to move the objective optical system to observe the other portion of the sample, in the same manner as moving the stage to observe the other portion of the sample (see References 6 and 7).

It would therefore have been obvious to a person having ordinary skill in the art to modify the invention described in Reference 1, in which the stages are moved to adjust a field of view, so as to move the objective optical system to adjust the field of view, thereby making the invention of claims 8 and 9 of the present application.

- Rejected claim(s): Claim 10
- Cited reference(s): References 1 to 7
- Note:

Reference 1 does not describe that the optical axis of the objective optical system is inclined relative to the optical axis of the eyepiece optical system and the optical axis of the objective optical system is placed in the opposite direction.

However, arrangement and a position of the optical axis of the eyepiece optical system, as well as the output beam path of the objective lens system merely represent obvious design choices, which may be determined appropriately by a person having ordinary skill in the art based on sizes of an object to be observed and an observing apparatus, observability, as well as a position of a desired object to be compared.

Therefore, inclining the optical axis of the objective optical system of the invention described in Reference 1 relative to the optical axis of the eyepiece optical system and determining arrangement of the respective elements of the comparison microscope so as to place the optical axis of the objective optical system in the opposite direction, thereby making the invention of claim 10 of the

present application would have been within a normal creative activity of a person having ordinary skill in the art and the invention of claim 10 of the present application would have been made obviously.

List of the references

1. Japanese Patent Publication No. S36-23124
 2. Japanese Patent Provisional Publication No. S60-17417
 3. Japanese Patent Provisional Publication No. S63-276015
 4. Japanese Patent Provisional Publication No. 2003-66336
 5. Japanese Patent Provisional Publication No. 2000-330031
 6. Specification of German Patent Provisional Publication No. 3116634
 7. Japanese Patent Publication No. S44-15306
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Record of the results of the Search Report

- Field in which the search has been conducted:
 - IPC G02B21/00, 21/06-21/36
 - G02B5/04
 - G03B15/00
 - G01N21/956
 - H04N21/66
- Prior art made of record
 - Japanese Patent Provisional Publication No. S50-129044
 - Japanese Patent Provisional Publication No. S53-59443
 - Japanese Patent Provisional Publication No. S52-80039
 - Japanese Utility Model Publication No. S35-10474
 - Japanese Utility Model Publication No. S29-15671
 - Japanese Utility Model Publication No. S9-6223

The record of the results of the Search Report does not constitute any rejection.

Any inquiry of the Office Action should be directed to the following
Examiner:

First Patent-Examination Division Applied Optics Mr. Yasunori SHIMIZU

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Fax. 03(3501)0478

Our Comments on the First Office Action

I. Currently Pending Claims

No amendment to claims has been made since the present application was filed. Therefore, claims 1 to 12, which correspond to claims 1 to 12 attached to your order letter of June 12, 2006, respectively, are currently pending in the present application.

II. Office Action

A. Cited References

The following four references are relied upon for rejection of claims:

- (1) Japanese Patent Publication No. S36-23124 (hereinafter referred to as "Reference 1");
- (2) Japanese Patent Provisional Publication No. S60-17417 (hereinafter referred to as "Reference 2");
- (3) Japanese Patent Provisional Publication No. S63-276015 (hereinafter referred to as "Reference 3");
- (4) Japanese Patent Provisional Publication No. 2003-66336 (hereinafter referred to as "Reference 4");
- (5) Japanese Patent Provisional Publication No. 2000-330031 (hereinafter referred to as "Reference 5").
- (6) German Patent Provisional Publication No. 3116634[✓] (hereinafter referred to as "Reference 6"); and
- (7) Japanese Patent Publication No. S44-15306 (hereinafter referred to as "Reference 7").

Each copy of References 1 to 7 is being sent separately together with the following documents for your information:

- (a) an English abstract (PATENT ABSTRACT OF JAPAN) of each of References 2 and 3; and
- (b) an English abstract (PATENT ABSTRACT OF JAPAN) and a computer-generated English translation of each of References 4 and 5.

It appears that there is no English version of each of References 1, 6 and 7..

B. Rejections

1. The Examiner's rejections may be summarized as follows:

- (1) Claims 1, 2 and 11 are rejected under Section 29(2) of Japanese Patent Law as

being unpatentable over References 1 to 3;

(2) Claims 3 and 4 are rejected under Section 29(2) of Japanese Patent Law as being unpatentable over References 1 to 5;

(3) Claims 5 to 7 are rejected under Section 29(2) of Japanese Patent Law as being unpatentable over References 1 to 5;

(4) Claims 8 and 9 are rejected under Section 29(2) of Japanese Patent Law as being unpatentable over References 1 to 7; and

(5) Claim 10 is rejected under Section 29(2) of Japanese Patent Law as being unpatentable over References 1 to 7.

2. We have not studied the references at this time and shall appreciate receiving your comments distinguishing the invention, as claimed, over the references as applied by the Examiner.

C. Objections

The Examiner has raised a formal objection. to claim 12. We need your clarification and/or proposed amendment to obviate the formal objection.
